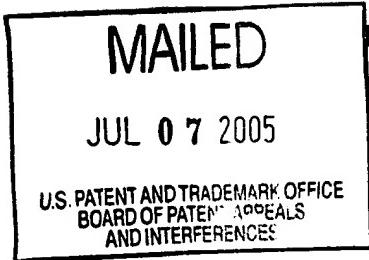


The opinion in support of the petition decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

DAVID W. DEATON and ROBERT SCOTT WOOD

Appeal No. 2004-0786
Application No. 08/935,116

DECISION ON PETITION

This is a decision on the petition filed January 3, 2005 under 37 CFR § 1.182 or alternatively under 37 CFR § 1.183 to have a decision of a panel of the Board of Patent Appeals and Interferences formally revised to clarify that the panel entered a new ground of rejection instead of an affirmance of the examiner's ground of rejection.

Pursuant to 37 CFR § 1.181(g) and 37 CFR § 41.3, the Director has delegated authority to decide petitions under 37 CFR §§ 1.182, and 1.183 from actions of the Board of Patent Appeals and Interferences or of personnel at the Board of Patent Appeals and Interferences to the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences. MPEP § 1002.02(f)(4)(b).

The petition under 37 CFR § 1.182 is DISMISSED.

The petition under 37 CFR § 1.183 is DENIED.

FINDINGS

1. On September 9, 2004, a merits panel composed of three administrative patent judges of the Board of Patent Appeals and Interferences, 35 U.S.C. § 6(b), entered a decision (BPAI Decision) affirming the decision of the examiner to reject claims 17-32 under 35 U.S.C. § 103(a); reversing the decisions of the examiner rejecting claims 8-16 and 33-39; and entered a new ground of rejection against claim 33.
2. The appellants did not file a request for rehearing within two months of the date of the BPAI decision as permitted by either 37 CFR § 1.197 (effective until September 13, 2004) or 37 CFR § 41.52 (effective from September 13, 2004).
3. 37 CFR § 41.52 reads as follows:

§ 41.52 Rehearing.

- (a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.
- (2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.
- (3) New arguments responding to a new ground of rejection made pursuant to §41.50(b) are permitted.

(b) Extensions of time under §1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See §1.136(b) of this title for extensions of time to reply for patent applications and §1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

4. On January 3, 2005, Petitioners David W. Deaton and Robert Scott Wood (Petitioners) filed the instant petition under 37 CFR § 1.182 or alternatively under 37 CFR § 1.183 to have the BPAI decision formally revised to clarify that the panel entered a new ground of rejection instead of an affirmation of the examiner's ground of rejection. Specifically, Petitioner seeks to have the "rejection under 35 USC 103 of claims 17-32 based upon Creekmore and Bigari, not an affirmation of the grounds of rejections asserted by the examiner of claims 17-32 under 35 USC 103 based upon Creekmore, Off, Tai, and Bigari, and provide the applicant two months from the date of the decision on this petition to act, pursuant to 37 CFR 41.50(b)" (Petition, page 2). That is, Petitioners seek the designation of the affirmation of this rejection to constitute a new ground of rejection.

5. The petition filed on January 3, 2005 is more than two months from the date of the BPAI decision.

6. 37 CFR §§ 1.181-1.183 read as follows:

§ 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support

thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

- (c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.
- (d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.
- (e) Oral hearing will not be granted except when considered necessary by the Director.
- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
- (g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

§ 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in §1.17(f).

§ 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(f).

7. 37 CFR § 41.3 reads as follow:

§ 41.3 Petitions.

- (a) Deciding official. Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.
- (b) Scope. This section covers petitions on matters pending before the Board (§§41.35, 41.64, 41.103, and 41.205); otherwise, see §§1.181 to 1.183 of this title. The following matters are not subject to petition:
 - (1) Issues committed by statute to a panel, and
 - (2) In pending contested cases, procedural issues. See §41.121(a)(3) and §41.125(c).
- (c) Petition fee. The fee set in §41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.
- (d) Effect on proceeding. The filing of a petition does not stay the time for any other action in a Board proceeding.
- (e) Time for action. (1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:
 - (i) File the petition within 14 days from the date of the action from which the party is requesting relief, and
 - (ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.
- (2) A party may not file an opposition or a reply to a petition without Board authorization.

8. Petitioners raise the issue of the timeliness of the petition by stating that it is not time barred (Petition, page 10). In support of this position, Petitioners state:

Since 37 CFR 1.182 does not provide a 2 month time limit, and this petition addresses an issue not specifically provided for, the petition should not be dismissed. Cf. Helfgott & Karas, P.C. v. Dickenson, 209 F.3d 1328, n.3; 2000 U.S. App. LEXIS 6922, n.3; 54 USPQ2d 1425, n.3 (Fed. Cir. 2000) (“Because Helfgott does not appeal the district court’s holding that the Commissioner properly applied the two month time period in section 1.181 to a section 1.182 petition, see Helfgott & Karas, 47 F. Supp. 2d at 433 n.5, we cannot reach this issue and rule in Helfgott’s favor--even though the time limit in section 1.181 seems by the plain meaning of the section to apply only to that section. We can note, however, that the Commissioner’s rejection of the section 1.182 petition for untimeliness necessitated the further expenditure of private and public

resources, as Helfgott pursued its request for relief and the Commissioner steadfastly refused to permit correction of the evident errors attributable to both parties.”)

9. 37 CFR § 1.181(f) was amended effective November 7, 2000 to clarify that the two-month time period applies to any petition filed under this part (i.e., 37 CFR part 1), except as otherwise provided. The pertinent portion of the rulemaking (65 Fed. Reg. 54646) reads as follows:

The Office has long considered the two-month period in § 1.181(f) to be the benchmark for determining the timeliness of petitions. *See Changes to Patent Practice and Procedure*, 62 FR at 53161, 1203 Off. Gaz. Pat. Office at 88 (the Office considers the two-month period in § 1.181(f) to be the appropriate period by which the timeliness of a petition should be determined). Nevertheless, there appears to be some confusion as to when other petitions (e.g., §§ 1.182 and 1.183) must be **filed** to be timely, or even whether there is any period within which other petitions must be **filed** to be timely. *See Helfgott v. Dickinson*, 209 F.3d 1328, 1333 n.3, 54 USPQ2d 1425, 1428 n.3 (Fed. Cir. 2000).

Therefore, the Office is revising § 1.181(f) to clarify that its two-month time period applies to any petition under 37 CFR part 1, except as otherwise provided. (Emphasis added.) Section 1.181(f) is also amended to provide that this two-month period is not extendable. A number of sections (e.g., §§ 1.377, 1.378, 1.644, 1.740) specify the time period within which a petition must be **filed** (or may be dismissed as untimely). The two-month time period in § 1.181(f) applies to a petition under any section that does not specify the time period within which a petition must be filed. (Emphasis added).

10. Petitioners further argue (Petition, page 10) that

Alternatively, you should deem this petition to request relief where justice demands, as a petition under 37 CFR 1.183. You should grant the relief requested because justice requires a fair decision on the issue of whether the panel's Creekmore/Bigari combination in fact suggests any claim, and rights will otherwise be lost due to issue preclusion. In this regard, the ambiguity caused by the panel's alleged affirmation of

the examiner coupled with their express new ground of rejection of claim 33 is sufficient reason to grant the relief requested in order to avoid preclusion of the issue of the Creekmore/Bigari based panel rejections of claims 17-32.

11. Petitioners have not provided any explanation as to why the petition or a request for rehearing under 37 CFR § 41.52¹ was not filed within two months of the date of the BPAI decision.

DISCUSSION

The petition under 37 CFR § 1.182 is dismissed as untimely.

Petitioners do not dispute that the petition under 37 CFR § 1.182 was filed after that the two-month period set under 37 CFR § 1.181(f). What is disputed is whether or not a petition under 37 CFR § 1.182 is subject to the two-month time period specified in 37 CFR § 1.181(f). See Finding No. 8.

As indicated above, the change to 37 CFR § 1.181(f), effective November 7, 2000, makes clear that the two-month time period applies to a petition filed under 37 CFR § 1.182. The literal language of the rule provides notice that the two-month time period set forth in 37 CFR § 1.181(f) applies “to any petition under 37 CFR part 1, except as otherwise provided,” including 37 CFR § 1.182. See Finding No. 9.

The petition under 37 CFR § 1.182 was filed after the two-month period set under 37 CFR § 1.181(f). See Finding No. 5. Thus, it is untimely in accordance with 37 CFR § 1.181(f). See Finding No. 9.

¹ A request for rehearing can include a request that an affirmance of the examiner’s ground of rejection be designated a new ground of rejection since such a request relates to a procedural aspect of the decision, not to the merits of the decision to affirm the rejection.

The alternative petition under 37 CFR § 1.183 is denied.

37 CFR § 1.183 provides that in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee on petition of the interested party, subject to such other requirements as may be imposed. See Finding No. 6.

Petitioners have not provided any explanation as to why the petition was not filed within two months of the date of the BPAI decision. See Finding No. 11. Thus, the petitioners have not set forth an extraordinary situation, where justice requires, the two-month period set in 37 CFR §1.181(f) be suspended or waived.

The petition under 37 CFR § 1.182 is DISMISSED as untimely.

The petition under 37 CFR § 1.183 is DENIED.



Michael Fleming
Chief Administrative Patent Judge
Board of Patent Appeals and Interferences

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA , VA 22304